

It is noted that the CAFC has stated:

"A patent applicant is free to recite features of an apparatus either structurally or functionally. See In re Swinehart, ...169 USPQ 226, 228. 'There is nothing intrinsically wrong with [defining something by what it does rather than by what it is] in drafting patent claims.'" In re Schreiber, 44 USPQ 2d (429, 1432 (emphasis added)).

See also MPEP 2173.05(g) and the Wright and K-2 cases discussed in previous responses.

Thus, the objection to claims 2-6, 8-12, 14-19, 21-24, 27-32, 35-39 and 41-45 under 37 CFR 1.75(c) should be withdrawn since these claims do properly limit the subject matter of the previous claim.

The Examiner has rejected claims 1-39 and 89-106 under 35 USC 102 on Whitney. For claims 1-39 he incorporated by reference the reasons in the office action of 1/1/02. In that Office Action these claims were rejected by ignoring certain of their limitations as being functional.

Looking at the independent claims, claim 1 recites the ordering of the postal data elements with a first one of the elements

being a function of the second one of the elements. Claim 7 recites the independence of the elements and an ordering. Claim 13 recites a first subset which is unaffected by the franking transaction and a second subset which is subject to change during franking and the output providing first and second parts. Claim 20 recites first and second symbols with the first being at least partially unaffected by franking and at least part of the second being affected. Claim 26 recites first data being a function of second data and generating the indicium when an actual version matches a predicted version. Claim 34 recites an authenticating code with selected computations being performed before a request for generating an indicium is received.

Since these limitation must be given patentable weight (see above), and since none of them are found in Whitney, the rejection of claims 1-39 under 35 USC 102 on Whitney should be withdrawn.

Further, since none of these limitations are suggested by Whitney, claims 1-39 are unobvious over this reference.

As the Examiner correctly states, claims 89-90, 92-93, 95-96, 101-102, and 104-105 further recite the printer and mail piece. Since they are dependent on allowable claims, see supra, they are necessarily allowable in view of Whitney. Further, since their respective functional limitations must be given patentable weight, they are allowable for this additional reason.

Claims 91, 94, 97-100, 103 and 106 additionally recite a medium or mail piece having a representation, symbol or indicium on it. The Examiner states that this is objectionable printed matter citing In re Gulack 217 USPQ 401.

Preliminarily, in In re Lowry, 32 USPQ 2d, 1031, 1034, the CAFC has stated:

"The printer matter cases have no factual relevance where the invention as defined by the claims requires that the information be processed not by the mind but by a machine, the computer."

And:

"While the information content affects the exact sequence of bits stored in accordance with Lowry's data structures, the claims require specific electronic structural elements which impart a physical organization on the information stored in memory."

Here, since a processor, i.e., a computer, is recited, printed matter cases are irrelevant in the first place. Further, since a physical organization (the order of the elements) is recited, the limitations must be given patentable weight.

Further, it is noted that in the cited Gulack case, it is stated on p. 403, footnote 8, that:

A "printer matter rejection" under §103 stands on questionable legal and logical footing. Standing alone, the description of an element of the invention as printed matter tells nothing about the differences between the invention and the prior art or about whether that invention was suggested by the prior art. A printed matter rejection is based on case law antedating the 1952 patent act, employing a point of novelty approach. In re Sterling, 70 F. 2d 910, 21 USPQ 519 (CCPA 1934). The 1952 act legislatively revised that approach through its requirement that the claim be viewed as a whole in determining obviousness. Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966). The CCPA has considered all of the limitations of the claims including the printed matter limitations, in determining whether the invention would have been obvious. See In re Royka, 490 F. 2d 981, 180 USPQ 580 (CCPA 1974); In re Cavrich, 451 F. 2d 1091, 172 USPQ 121 (CCPA 1971). In Royka, 490 F.2d at 985, 180 USPQ at 583, the CCPA, notably weary of reiterating this point, clearly stated that printed matter may well constitute structural limitations upon which patentability and be predicted. (emphasis in original)

Although here there is a rejection under 35 USC 102 rather than 35 USC 103, the basic principles of considering all limitations, including the printed matter limitations and that printed matter may well constitute structural limitations, apply.

While it is true that, as the Examiner states, there must be a functional relationship between the printer matter and the substrate, it is respectfully submitted that the Examiner's holding that the function of the envelope remains the same, e.g. a container for letters, is too narrow. After all in Gulack the function of the bond or ring, e.g., a belt, with or without the imprinted digits remains the same, e.g., to hold up pants. The same is true for the other examples of a band or ring in that case, e.g., a hat still covers a head. There the functional relationship was between the sequence of digits and the derivation of that sequence to the band or ring (p. 405). Here it is, e.g., the ordering of postal data elements (claim 1) and the other features of the remaining independent claims as set forth above to the envelope.

In summary, the printed matter cases are irrelevant, and even if they are relevant, they must be narrowly construed. Further, even if they apply, since there is a structural relationship between the "printed matter" and the substrate, the limitations must be given patentable weight. Thus the rejection of claims 91, 94, 97-100, 103 and 106 under 35 USC 102 on Whitney should be withdrawn.

Further, since there is no suggestion in Whitney for the various features of these claims, they are unobvious over Whitney.

Similarly, all limitations in claim 40, including functional ones, must be given patentable weight. In particular, Gilham does not show that the size of the gap being a function of the

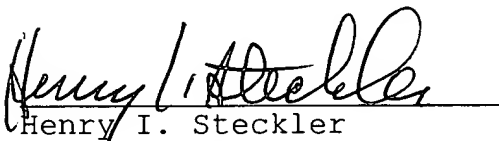
size of the delimiter. Thus the rejection of claims 40-45 under 35 USC 102 on this reference should be withdrawn.

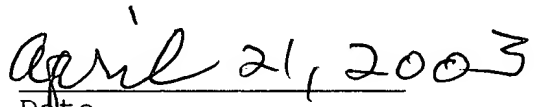
Further, since there is no suggestion of this feature therein, claims 40 - 45 are unobvious over Gilham.

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,


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